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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,293	06/27/2001	Wouter E. Roorda	50623.00041 (2742)	5539
30256	7590	05/27/2004	EXAMINER	
SQUIRE, SANDERS & DEMPSEY L.L.P			MICHENER, JENNIFER KOLB	
600 HANSEN WAY			ART UNIT	PAPER NUMBER
PALO ALTO, CA 94304-1043			1762	

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/894,293

Applicant(s)

ROORDA, WOUTER

Examiner

Jennifer K. Michener

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1, 2, 5, 9-13, 15-18, 20-22 and 24-34, 36-44.

Claim(s) withdrawn from consideration: 35.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

DETAILED ACTION

1. The reply filed 4/22/2004 fails to place this application into condition for allowance.
2. The proposed amendments will not be entered because they raise new issues that would require further consideration and/or search and they raise the issue of new matter. Applicant alleges that the claim amendments were implemented "to explicitly recite steps that were previously inherent in the claims". However, Examiner notes that amending the claim from "spraying" to "atomizing the coating substance with a gaseous propellant" would require further search and/or consideration. Additionally, Examiner understands that any atomization process would inherently require "providing" a coating substance, "atomizing" it, and "directing" it, as the claim would require if amended. However, new matter issues must be investigated, particularly involving claims such as claim 5, which, as amended, would require repetition of the "providing, atomizing, directing" steps. While the step of spraying or directing is taught to be repeated by the instant specification, the specification does not appear to have basis for providing separate "providing" and "atomizing" steps prior to each and every "directing" step. Additionally, amended claims would newly require a "dissolved" polymer.

For these reasons, the proposed amendments will not be entered.

Response to Arguments

3. Applicant's arguments filed 4/22/2004 have been considered, but they are not persuasive.

Applicant argues that he is unable to document that Pursley's term "solvenated polymer" means "a dissolved polymer" and traverses any future Official Notice taken by Examiner.

Pursley teaches a powdered polymer or a solvenated polymer. It is Examiner's position that one of ordinary skill in the art of chemistry or coating would have *immediately* recognized that a solvenated polymer is one that is provided in a solvent, as taught by U.S. Pat. 4,636,254 which states that a solvenated resin is one that is dissolved in a solvent.

Applicant argues that Pursley's catheter liner is "incapable of being implanted until after it is turned into a catheter".

As outlined in at least one of the previous office actions, Pursley's catheter comprises a coated liner. The uncoated liner is just as implantable as the medical device of Applicant's prior to receiving its coating. Examiner also notes that the non-entered claim limitation merely requires "capable of being implanted" and is not an active method step. Clearly an uncoated medical device has the *capability* of being implanted. Furthermore, Pursley's liner does indeed get implanted, albeit with a coating on it, and is therefore *capable* of such, just as the medical device of Applicant because Applicant's medical device is provided and said to be "implantable" by the claim before it is coated.

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Applicant argues that Fan teaches a single coating, not multiple coatings.

As outlined in the previous office actions, repetition of steps is an obvious variation.

Applicant argues that Fan's use of specific polymers, etc. would not allow respective combination with Zhong, Pursley, or Whitbourne in her separate rejections and argues that a prima facie case is not made.

Examiner has cited Zhong as a secondary reference merely to teach the substitution of spraying for immersion and to teach the movement of the gas tool. Likewise Pursley was cited with Fan merely to teach pre-heating and Whitbourne teaches interchangeability of polymers. Motivational statements and statements of obviousness are clearly outlined in the previous office action and are not reiterated herein.

Applicant reiterates that the use of solvenated polymer is mentioned only in passing by Pursley and not taught by examples.

Examiner maintains that a teaching has been made. Examples of the reference are merely exemplary.

Applicant reiterates arguments regarding time savings in a drying step leading to inferior results arguing that one of ordinary skill would not know that the benefit in time savings would be worth the sacrifice in quality. Applicant argues that using Examiner's

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reasoning "Applicant's production of acceptable coatings when omitting the step is unexpected".

Examiner has thoroughly addressed these arguments in the previous office action and maintains that one of ordinary skill in the art would have expected that the omission of a method step would result in the consequent loss of its benefit. The ordinary artisan is not required to quantify such a loss in advance in the reference. The ordinary artisan would have known that decreasing drying time inherently saves time. Furthermore, as Applicant noted, Ofstead even teaches that without air-drying, an inferior coating forms. Therefore, there is a teaching within the Ofstead reference which makes clear that the method of performing the method of his invention *without air drying* is known and has been performed. While Ofstead finds the results "inferior", that does not preclude such results from being "acceptable" to Applicant or one of ordinary skill for a desired operation.

Applicant argues that Ding does not teach atomizing.

Examiner notes that the claims do not require the non-entered amendment limitations.

Applicant argues that Bouchier is not combinable with various references, such as Zhong.

Zhong is cited merely to teach interchangeability of spraying for immersion.

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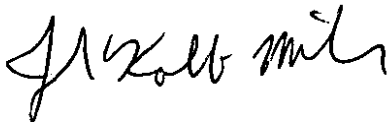
Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Goicoechea is cited for teaching applying coating to a rotating stent on a mandrel and then blowing hot air on the stent to decrease evaporation time (col. 4, lines 50-55).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Michener whose telephone number is 571-272-1424. The examiner can normally be reached on Monday through Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on 571-272-1415.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Jennifer Kolb Michener
Patent Examiner
Technology Center 1700
May 19, 2004